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In re Application of :
Rice et al. :
Application No.: 10/525,596 : DECISION
PCT No.: PCT/AU03/01075 :
Int. Filing Date: 22 August 2003 : ON
Priority Date: 23 August 2002 :
Attorney Docket No.: 84533-000000US : PETITION
For: Depletion of Plasma Proteins :
:

This is in response to the petition under 37 CFR 1.47(a) filed on 25 April 2006.

BACKGROUND

This international application was filed on 22 August 2003, claimed an earlier priority date of 23 August 2002, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 04 March 2004. The 30 month time period for paying the basic national fee in the United States expired at midnight on 23 February 2005. Applicants filed *inter alia* the basic national fee on 23 February 2005

On 20 September 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration in compliance with 37 CFR 1.497(a) and (b).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), petitioner paid the petition fee on 25 April 2006.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of joint inventor Mark S. Baker be excused because "it may be concluded that joint inventor Mark Baker remains uncooperative and refuses to execute the inventors' declaration." Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application

papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Counsel presents evidence of efforts undertaken to obtain Mr. Baker's execution of the declaration of inventorship. This evidence does not include an explicit refusal on the part of Mr. Baker; indeed, his letter of 18 April 2005 states that he was "willing to comply if you are able to provide me with information that I require in order to execute this process." Moreover, petitioner has not made out a case that Mr. Baker's conduct constitutes a constructive refusal to execute the declaration. As noted in the MPEP excerpt *supra*, relief on the basis of refusal requires that the allegedly refusing inventor have been presented with a complete copy of the application papers. However, the evidence currently of record suggests that Mr. Baker was not presented with a complete copy of the application prior to that accompanying Elizabeth Kennedy's letter mailed 20 March 2006. This was a mere two weeks prior to Ms. Kennedy's statement on 03 April 2006 that "I have received no further correspondence from Baker." It is not clear that this would constitute a reasonable time period for the application to reach Mr. Baker, for Mr. Baker to review the matter, and for an executed declaration to be returned to counsel. Also, there is no verification that Mr. Baker received the letter of 20 March 2006. Although Atty. Parmelee states that he has not "been advised of any contact as of the filing date of this paper," it is not clear whether Atty. Parmelee contacted Ms. Kennedy to verify that Mr. Baker had not yet replied as of that date. As such, it would not be appropriate under the circumstances presented to construe Mr. Baker's behavior to constitute a refusal to execute the oath or declaration within the meaning of 37 CFR 1.47(a).

Regarding requirement (3), the petition includes a statement the last known address of Mr. Baker. Accordingly, requirement (3) has been satisfied.

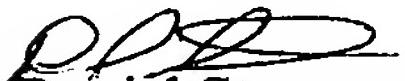
Regarding requirement (4), the petition is accompanied by a declaration document signed by joint inventors Gregory E. Rice and Michael Quinn on behalf of themselves and non-signing joint inventor Mark S. Baker. This declaration satisfies requirement (4).

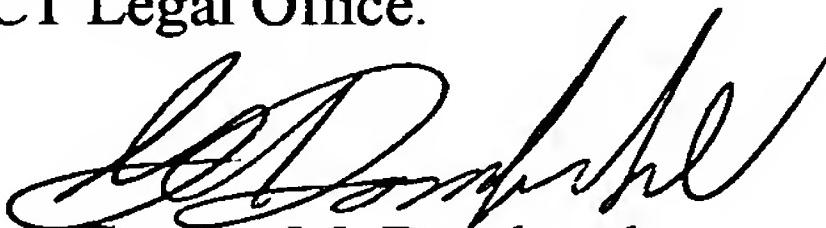
DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.


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